

IN THE U.S. PATENT AND TRADEMARK OFFICE

Application No.: 09/751,159 Conf. No.: 8689
Filing Date: December 28, 2000 Group Art Unit: 2623
Applicant: Marc P. Kaplan et al Examiner: unknown
Title: SYSTEM AND METHOD FOR DISTRIBUTING VIDEO WITH TARGETED
ADVERTISEMENTS USING SWITCHED COMMUNICATION NETWORKS

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR
§1.181(a) et seq. OR, IN THE ALTERNATIVE TO REVIVE AN
UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R.
§1.137(b)**

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September 8, 2010

Sir:

I. PETITION TO WITHDRAW

Applicant hereby petitions for withdrawal of the holding of abandonment in the above-identified application because the Notice of Abandonment dated July 18, 2007 was improperly issued.

The Applicant's attorney, John E. Curtin, hereby submits the following statement in support of this Petition. Applicant's attorney requests that the Petitioner's group telephone the undersigned on (703) 266-3330 prior to its decision on the instant Petition to clarify any issue.

**A. STATEMENT BY APPLICANT'S ATTORNEY IN SUPPORT OF
PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

- 1.) On July 3, 2006 the Examiner at the time, John Manning, mailed a Final Office Action to the Applicants' attorney. On September 1, 2006 the Applicants filed a timely Amendment After Final (AAF) which placed the subject matter from dependent claims 6 and 16 into independent claims 1, 12 and 20.
- 2.) On September 19, 2006 the Applicants received an Advisory Action (AA#1) which indicated that the amendments in the AAF would not be entered because the proposed amendments "do not merely cancel claims, adopt Examiner suggestions, remove issues for appeal, or in some other way requires only a cursory review by the Examiner" (see "Continuation Sheet" within AA#1 Action).
- 3.) Because the amendments within the AA#1 had simply cancelled dependent claims and placed the cancelled features into the independent claims, the Applicants' attorney called the Examiner in an attempt to understand the AA#1. As of October 3, 2006 no response was received from the Examiner. To preserve the Applicants' rights, the Applicants' attorney filed a Notice of Appeal on October 3, 2006.
- 4.) On December 4, 2006, the Applicants' attorney again called the Examiner and left a message that the Applicants were filing a Supplemental Amendment After Final (Supplemental AAF) in an attempt to address the AA#1. The Supplemental AAF added features from intervening dependent claims 5 (intervening for claim 6) and 15 (intervening for claim 16) into independent claims 1 and 12, respectively. Independent claim 20 was also amended to conform it to the other independent claims
- 5.) The following day, December 5, 2006 the Applicants timely filed an Appeal Brief. The Appeal Brief contained a claim set that was identical to the set in the Supplemental AAF.
- 6.) On February 13, 2007 the Applicants' received a second Advisory Action (AA#2). The AA#2 stated that the amendments in the Supplemental AAF would not be entered because the proposed amendments would require further search or consideration despite the fact that the amendments were all based on features from dependent claims that had previously been searched.
- 7.) On February 27, 2007 the Applicants received a Notification of Non-Complaint Appeal Brief which indicated that the "brief does not contain a correct copy of the appealed claims".
- 8.) On February 27, 2007 the Applicants' attorney called the Examiner. Upon calling the Examiner's telephone number the Applicants' attorney received a recorded, audible announcement that the Examiner's phone number was no longer in service. The Applicants' attorney then called the Examiner's Supervisory Patent

- Examiner (SPE#1). SPE#1 informed the Applicants' attorney that the Examiner was no longer with the USPTO.
- 9.) On March 15, 2007 the Applicants' attorney conducted a telephonic interview with a new Examiner (Examiner#2) and second SPE (SPE#2). During the interview Examiner#2 indicated that original claims 6 and 16 should be re-written as independent claims.
- 10.) On March 27, 2007 the Applicants submitted a Corrected Appeal Brief which included independent claims 1 and 12. Claim 1 included all of the subject matter of claim 6 and intervening claim 5. Claim 12 included all of the subject matter of claim 16 and its intervening claim 15. The Corrected Appeal Brief also cancelled those claims that the Examiner had requested during the interview to be cancelled. By so doing, the Applicants placed the subject matter of claim 6 and 16 into independent form, though the claims were numbered 1 and 12, and not 6 and 16.
- 11.) On July 18, 2007 the Applicants received a Notice of Abandonment (Notice). The Notice states that the Applicants filed a second defective appeal brief. The Notice was signed by a third SPE (SPE#3). On the last line of the Continuation Sheet of the Notice, SPE#3 took the position that "...claims 1 and 12 are in fact broader than claims 6 and 16 as all the limitations of the original claims 6 and 16 (including claims 5 and 15 respectively) were not added to the independent claims". Applicants submit that this is incorrect
- 12.) Believing that the USPTO's Board of Patent Appeals & Interferences' processing group or the SPE#3 had made a clerical error, and had not received or reviewed the correct set of claims, the Applicants' attorney began to prepare a petition to withdraw the Notice.
- 13.) To illustrate the fact that the subject matter of claims 1 and 12 submitted in Applicants' Corrected Appeal Brief is the same as the subject matter of claims 6 and 16 presumably expected by Examiner#2, the Applicants have submitted a comparison of independent claims 1 and 12 set forth in Applicants' December 5, 2006 Corrected Appeal Brief with claims 6 and 16 presumptively amended to include claims 1,5 and 12, 15, respectively (see ATTACHMENT A). From this comparison it can be seen that the scope of claims 1 and 12 set forth in Applicants' Corrected Appeal Brief is the same as the presumptive scope of claims 6 and 16 requested by Examiner#2 during the March 15, 2007 interview. Further, all of the limitations of the original claims 6 and 16 (including claims 5 and 15 respectively) were added to independent claims 1 and 12 included in the Corrected Appeal Brief. The only difference between the two sets of claims is that in the set submitted by the Applicants, in line 4, the phrase "via the switched network" is used while in the amended claims presumptively requested by the Examiner the phrase "in the ATM-based network" is used. However, because the word "the" (as in "the switched network") in Applicants' submitted claim set has

- as its antecedent basis, "an ATM-based switched communications network" (see preamble), there is no difference in scope whatsoever.
- 14.) Before the petition was finalized, on July 30, 2007 the USPTO announced proposed rule changes to its appeal procedures (*see* page 41472 Federal Register, Vol. 72, No. 145, Monday, July 30, 2007)(attached). Uncertain as to how the new rules might affect the petition, and desiring to avoid duplicate petitions, the Applicants did not immediately file a petition (*see for example*, the proposed rule "Amendments And Evidence Filed After Appeal And Before Brief", page 41473).
- 15.) On June 10, 2008 the proposed rule changes were finalized, with an effective date of December 10, 2008 (*see* page 32938, Federal Register, Vol. 73, No. 112, Tuesday, June 10, 2008) (attached). In the finalized rules, the rules stated that the new rules would apply to "all appeals in which an appeal brief is filed on or after the effective date". This still left unsettled whether in Applicants' petition any corrected appeal brief submitted as a part of the petition should comply with the previous appeal rules or the new rules and whether any Reply Brief filed by the Applicants would be subject to the new rules. On December 10, 2008 the USPTO delayed the implementation of the new appeal rules (*see* page 74972, Federal Register, Vol. 73, No. 238, Wednesday, December 10, 2008, attached).
- 16.) In January, 2009 the Applicants' attorney called Ms. Earlene Green, Special Program Examiner to ask for her assistance on how to proceed with either a petition or resolving the issue without the need for a petition. The Applicants' attorney had previously, successfully worked with Examiner Green to resolve issues related to other applications without filing a petition. This assistance was greatly appreciated. The Applicant's attorney wrote Examiner Green an email dated April 7, 2009 referring to the instant application and another application as well (attached). Though the email is mainly directed at the other application and informalities, the Applicants' attorney and Examiner Green discussed both applications.
- 17.) As instructed by Examiner Green, on April 9, 2009 the Applicants' attorney spoke with Ms. Sharmela Coates, of the BPAI's processing group. Applicants' attorney requested that Ms. Coates explain the basis of the Notice of Abandonment and brought to Ms. Coates attention the Supplemental AAF, Corrected Appeal Brief and the March 15, 2007 interview.
- 18.) Approximately one week later Ms. Coates telephoned the Applicants' attorney and indicated that the BPAI processing group was not responsible for generating the Notice and, therefore, could not comment on the reasons for issuing the Notice. Ms. Coates referred the Applicants' attorney back to the Examining group.
- 19.) On April 30, 2009, as suggested by Examiner Green, Applicants' attorney telephoned Special Program Examiner Kenneth Wieder. After explaining the history of the application to Examiner Wieder the Applicants' attorney requested

assistance in either filing a petition or resolving the issue without the need to file a petition. The Applicants' attorney sent Examiner Wieder an email dated May 18, 2009 summarizing the Applicants' request along with a number of attachments. (The May 18, 2009 email essentially incorporated Applicants' earlier email to Examiner Green).

- 20.) On May 6, May 14 and June 10, 2009 the Applicants' attorney telephoned Examiner Wieder to ascertain the status of Examiner's Wieder's investigation. Approximately one week after Applicants' attorney's June 10, 2009 phone call Examiner Wieder telephoned the Applicants' attorney and acknowledged the earlier phone calls, though the Examiner was still reviewing the matter.
- 21.) On April 10, 2010 the Applicants' attorney telephoned Examiner Wieder to determine the results of the Examiner's investigation. On April 27, 2010 Examiner Wieder telephoned the Applicants' attorney and apologized for the delay in responding, but then indicated that he was no longer responsible for the instant application. Examiner Wieder referred the Applicants' attorney to Special Examiner Grant.
- 22.) After speaking with Examiner Grant by telephone, on information and belief Examiner Grant studied the file history of the instant application. On May 5, 2010 Examiner Grant requested that the Applicants file a petition requesting withdrawal of the Notice of Abandonment. This petition followed.

B. REQUEST TO WITHDRAW HOLDING OF ABANDONMENT

As set forth above, the Notice of Abandonment is improper because, contrary to the statement made in the Notice, the scope of claims 1 and 12 contained in Applicants' March 27, 2007 Corrected Appeal Brief is the same as the scope of amended claims 6 and 16 requested by the Examiner during the March 17, 2007 interview.

Based on all of the above, the Applicant respectfully requests withdrawal of the holding of abandonment in this application.

APPLICANT HEREBY PETITIONS FOR WITHDRAWAL OF THE HOLDING OF
ABANDONMENT IN THIS APPLICATION.

1. Petition Fee:

 X No Fee is believed due.

2. Reply and/or Fee:

 X No reply or fee is believed due.

3. Terminal Disclaimer with disclaimer fee

 X Since this utility/plant application was filed on or after
June 8, 1995, no terminal disclaimer is required.

If however, a fee is deemed necessary, the Commissioner is hereby authorized in this,
concurrent, and future replies, to charge payment for any such fee, or credit any overpayment to
Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under
37 C.F.R. § 1.17; particularly, petition fees or extension of time fees.

PETITION TO REVIVE

In the event the Applicant's Petition to Withdraw is not granted, the Applicant hereby alternatively petitions for revival of the above-referenced application. The above-identified application was unintentionally abandoned for failure to file a Corrected Appeal Brief. The entire delay in filing the Corrected Appeal Brief, from the due date for filing the Corrected Appeal Brief until the filing of this petition under 37 CFR 1.137(b) was unintentional. Thus, the abandonment was unintentional.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

1. Petition Fee

_____ Small Entity - fee \$_____ (37 CFR 1.17(m))

_____ Small Entity Statement enclosed herewith.

_____ Small Entity Statement previously filed.

X Other than Small Entity - fee **\$1,620** (37 C.F.R. 1.17(m)). The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for this fee, or credit any overpayment, to Deposit Account No. 50-3777 as well as for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; **particularly, petition, or extension of time fees.**

2. Reply and/or Fee

Because it is unclear at this point whether Applicants' Corrected Appeal Brief will be accepted, the Applicants are filing a Request For Continued Examination, fee and Amendment in response to the last Final Office Action (enclosed).

3. Terminal Disclaimer with disclaimer fee

 X Since this utility/plant application was filed on or after
June 8, 1995, no terminal disclaimer is required.

4. Statement. The entire delay in filing the required Corrected Appeal Brief from the due date for the Corrected Appeal Brief until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

September 8, 2010
Date:

/John E. Curtin/
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FIRM, PLLC**

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